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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,340	02/06/2004	Asutosh Nigam	8500-0256.10	5320

23980 7590 01/24/2007
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
1400 PAGE MILL ROAD
PALO ALTO, CA 94304-1124

EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/774,340

Applicant(s)

NIGAM, ASUTOSH

Examiner

Monique R. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41, 43-47, 49-56 and 58-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41, 43, 44, 46, 47, 49-51, 53-56, 58, 59, 61 and 62 is/are rejected.
- 7) ☒ Claim(s) 45, 52 and 60 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/26/06 has been entered. Claims 42 and 57 have been canceled. Claims 1-41, 43-47, 49-56 and 58-62 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Upon reconsideration, the indicated allowability of claims 1-40, 47, and 49-55 is hereby withdrawn in view of the following rejections.

Claim Rejections - 35 USC § 112

3. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites a "process for producing a dry image on a substrate, comprising...(a) applying to the...substrate, to form an opaque coating thereon, an opaque coating composition...(b) contacting the coated substrate with a recording liquid that renders the opaque coating partially or entirely transparent." Since Claim 1 recites that the opaque coating can become entirely transparent, it is unclear from the two process steps recited how an image is formed on the substrate. Is an image pre-printed on the substrate and hence revealed when the opaque coating become entirely transparent? Is the recording liquid provided in a desired pattern and only that portion of the opaque coating that comes in contact with the patterned recording liquid is rendered entirely transparent, as opposed to the entire opaque coating?

Double Patenting

4. Claims 1, 2, 5-30, 36-41, 43, 44, 46, 47, 49-51, 53-56, 58, 59, 61 and 62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-18, 29-37, 39-44, 46-49 and 51 of U.S. Patent No. 6,241,787. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to recognize that the claimed metallic substrate of '787 reads upon the instantly claimed reflective substrate or substrate with a reflective surface; and to combine dependent claim limitations to arrive at the claimed invention. Though '787 does not specifically claim that the image-enhancing composition changes from opaque to transparent when a dye composition or printing ink or "recording liquid" is applied, the Examiner takes the position that the image-enhancing composition of '787 would possess the same coating properties as instantly claimed considering the image-enhancing composition of '787 comprises the same composition as the instantly claimed opaque coating composition. Further, considering '787 claims a substrate comprised of a metal or a laminate, it would have been obvious to one having ordinary skill in the art to utilize a metal laminate, such as a metallized film or paper/metal foil laminate, which are obvious species of metal laminates in the art.

5. Claims 45, 52, and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed 10/26/06 have been considered but are moot in view of the new ground(s) of rejection.

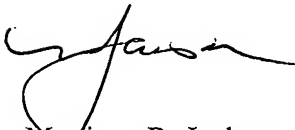
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508.

The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monique R. Jackson
Primary Examiner
Technology Center 1700
January 22, 2007